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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,765	08/23/2000	Teruyuki Motohashi	Q60573	9997

7590 10/24/2002

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EXAMINER

HARRY, ANDREW T

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 10/24/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/643,765

Applicant(s)

MOTOHASHI, TERUYUKI

Examiner

Andrew T Harry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.                      6) ☐ Other: .

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 4, and 7 teach that portable radio terminal with an infrared communications function that detects the state of the radio communication function then, based on the activity of the radio communication function, judges the amount of current that will be allocated to the infrared (IR) communication function, if the user would chose to use the IR function. The Examiner, after scouring the specification, was unable to derive a motivation or operational situation in which the user of such a device would find it necessary to use the radio communications function and the IR function simultaneously. There is also an issue with the actual position of the phone while this simultaneous operation is ongoing. It is obviously known in the art that IR is a line-of-sight (LOS) method of communications and that portable radio terminals are typically characterized as cellular telephones (see *Instant Specification*, p. 1 lines 20-25) which are held up to users ears for operation. Therefore the user of this device would have a radio terminal (cell phone) held to their ear while trying to communicate via LOS with the IR function of the cellular phone. The likely way to overcome this obstacle would be to describe

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the device as a personal digital assistant (PDA), or to explain that the cellular phone is enabled with a headset or hands-free type of device to allow for this operation. The specification, however, does not disclose either one of these alternatives as embodiments of the claimed invention.

Claims 2-3, 5-6, and 8-9 depend from claims 1, 4, and 7 respectively and are therefore also rejected on the same grounds.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Liukkonen et al.*** U.S. Patent 6,230,214 [hereinafter referred to as “*Liukkonen*”], and further in view of ***Descombes*** U.S. Patent 6,377,429 [hereinafter referred to as “*Descombes*”].

As pertaining to **claim 1, 4, and 7**, *Liukkonen* teaches a communication method and apparatus for a portable radio terminal with an IR communication function including an information processing section (see *Liukkonen*, col. 3 lines 30-45). However, the concept of judging whether or not the radio communications function is in communication and assigning a driving current/controlling the IR output, to the IR communication section based on that result is not disclosed by *Liukkonen*. *Descombes*, teaches a protective circuit for a battery that limits the amount of current drawn from the battery, by multiple loads to prevent permanent damage from occurring to the battery (see *Descombes*, col. 3 lines 32-55). It would have been obvious to one

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of ordinary skill in the art at the time of the invention to add to *Liukkonen, Descombes*' method of controlling the current that is drawn away from the battery in the phone, and by doing this the driving current of the IR function would be limited by the battery circuit described by *Descombes*. This addition would have allowed the battery in *Likkonens*' device<sup>3</sup> to operate without causing harm to the battery used to provide current to the IR function and radio communication function in his device.

As pertaining to **claims 2, 5, and 8**, *Liukkonens*' teachings as modified by *Descombes* above regarding claims 1, 4, and 7, teaches that the driving current of the light emitting diode (battery load) can be controlled in accordance with the power allocated to it in accordance with a reduced transmission power value (see *Descombes*, col. 4 line 51-col. 5 line 10).

As pertaining to **claims 3, 6, and 9**, *Liukkonens*' teachings as modified by *Descombes* above regarding claims 1, 4, and 7, teaches that the current supplied to the LED, and thus the IR function is reduced (see above rejection). It would have been obvious to one of ordinary skill in the art at the time of the invention to know that with a reduced current supply to the LED that the IR function of the device would be restricted and this would be communicated on the display of the device. This would allow the user to understand why the IR function may not be working in an expected way or to inform the user that to use the IR function they would have had to move closer to the source which they are attempting to communicate with.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C. Smith et al. U.S. Patent 6,014,030 teaches a current-level monitor with hierarchical precision.

D. Wiedeman et al. U.S. Patent 6,272,325 teaches a method and apparatus for considering user terminal transmitted power during operation in a plurality of different communication systems.

E. Nykanen et al. U.S. Patent 5,835,862 teaches a data adapter unit for IR communications.

F. Stenman et al. U.S. Patent 6,223,029 teaches a combined mobile telephone and remote control terminal.

G. North U.S. Patent 6,081,558 teaches an apparatus and method for low power operation with high sensitivity in a communications receiver.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Harry whose telephone number is 703-305-4749. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ATH

October 10, 2002

  
THOMAS G. WILKINSON  
P. Wilson